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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,409	03/28/2002	Hideki Aikoh	10873.882USWO	4963
53148	7590	03/15/2006	EXAMINER	
HAMRE, SCHUMANN, MUELLER & LARSON P.C. P.O. BOX 2902-0902 MINNEAPOLIS, MN 55402			DINH, TAN X	
			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/089,409		AIKOH ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	TAN X. DINH		2653	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13,14,19,20,22,23,25 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-4,8,11,12,18,21 and 24 is/are rejected.
- 7) ☒ Claim(s) 5,6,9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1) A Request for Continued Examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/2006 has been entered.

2) The I.D.S filed 6/10/2005 has been partially considered by the Examiner.

The information disclosure statement filed 6/10/2005 *fails* to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document. The foreign patent document identifies as 0-863-503 (E.P.O), September 1998, has not been considered at this time since no copy has been submitted.

Until now, no copy of this document has been submitted by applicant yet.

Applicant is required to re-submitted another form PTO-1449 and the copy of this document in next communication for consideration.

3) The preliminary amendment filed 12/13/2005 is acknowledged. Claims 7,15-17 have been canceled. New claims 21-26 are currently been added.

4) Claims *5,6,9 and 10* are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in alternative only. See MPEP § 608.01(n). Accordingly, the claims *5,6,9 and 10* not been further treated on the merits.

The rejection may be overcome by replace " any of claims ... " to " any one of claims ... ".

5) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7) Claims 1,3,12,18,21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAGATAKI et al ( 5,527,479 ).

NAGATAKI et al discloses an optical recording medium as claimed in claims 1 and 3, comprising a substrate ( Fig.1, substrate 1 ), a pit information surface ( Fig.1, 3 ), a protective layer ( Fig.1, protective layer 6 ), which uses in magnetic field modulation type magneto-optical disk and formed of formed of an ultraviolet curable resin coated with silicone oil ( column 1, lines 9-18 and column 2, lines 1-6. see also Fig.1, protective layer 6 coats with silicone oil layer 7 and column 5, lines 45-53 ), except to specifically show that the optical recording medium is read-only or partial recorded disk. It would have been obvious to someone within the level of skill in the art at the time of the invention was made to replace the optical recording medium of NAGATAKI et al by a read-only or partial recorded optical disk as claimed, the rationale is as follows:

(a) the read-only optical disk or partial recorded optical disk are old and widely used in the art, evidence on KAMEZAKI et al ( 5,904,969 ), figure 6, 11a, and in NISHIUCHI et al ( 5,764,619 ) column 26, lines 8-14, and

(b) in column 1, lines 9-18 NAGATAKI et al teaches that his invention is used to lubricate in general for use in magnetic recording, optical recording, magneto-optical recording and like

Art Unit: 2653

recording media in the form of disk, tape, etc., which includes any types of optical recording medium ( read-only optical disk, partial recorded optical disk, etc., ), therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to use the lubricated as taught by NAGATAKI et al on read-only optical disk or partial recorded optical disk as claimed.

The optical disk device claims 12 and 18 are drawn to the device of using the corresponding optical disk claimed in claim 1. Therefore, device claims 12 and 18 are rejected for the same reasons of anticipation (obviousness) as used above.

As to claims 21 and 24, to form the printing layer at any locations on the optical disk are old and well known in the art ( See Wen Xin et al ( JP, 10-308036, figure 1, layer 16 ).

8) Claims 2,4,8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAGATAKI et al ( 5,527,479 ) further in view of KAMEZAKI et al ( 5,904,969 ).

NAGATAKI et al discloses an optical disk as claimed in claims 2,4 and 11, comprising a substrate ( Fig.1, substrate 1 ), a pit information surface ( Fig.1, 3 ), a protective layer formed of an ultraviolet curable resin coated with silicone oil ( Fig.1, protective layer 6 coats with silicone oil layer 7. See also column 5, lines 45-53 ), which suites for floating type magnetic field

Art Unit: 2653

modulation of sliding type magnetic field modulation ( column 1, lines 9-18 and column 2, lines 1-6. In this case, protective layer 6 coats with silicone oil is capable for any types of magneto-optical recording disks ), except to specifically show a printing layer. KAMEZAKI et al from the same field teach an optical recording medium having a printing layer ( Figure 5, printing layer 8 ). It would have been obvious to someone within the level of skill in the art at the time of the invention was made to use a printing layer in NAGATAKI et al's optical disk, the rationale is as follows: the technique of using printing layer for labeling the optical disk are widely used in the art as seen in KAMEZAKI et al's figure 5, printing layer 8, every optical disk, such as, CD, DVD or MD, are included a printing layer for displaying the graphic, label or other information related to the optical disk, the printing layer can be placed at any locations on the disk, under or over the protective layer since the protective layer is transparent. Therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to use a printing layer under transparent protective layer as claimed.

As to claim 8, it would have been obvious to coat a lower viscosity on read-only optical disk than magnetic field modulation type magneto-optical disk since on read-only optical disk the magnetic head does not perform recording and erasing, just

Art Unit: 2653

reproducing only, during sliding or floating, the magnetic head and the protective layer will be damaged, by coating a lower viscosity on read-only optical disk the damage of magnetic head and protective layer is reduced to minimal.

9) Claims 13,14,19,20,22,23,25 and 26 are allowed.

10) Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

11) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

( see form PTO-892 attached herein ).

Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable arts ) the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made.

Applicant *must also show how the amendments avoid such references and objections.* See 37 CFR § 1.111(c).

12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN Xuan DINH whose telephone number is (571) 727-7586. The examiner can normally be reached on MONDAY to FRIDAY from 8:00AM to 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.



Art Unit: 2653

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**TAN DINH**  
**PRIMARY EXAMINER**

March 13, 2006